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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,376	11/09/2001	Richard Ciapala	MSFT-0764/154583.1	2868
7590	10/20/2004		EXAMINER	
Peter M. Ullman Woodcock Washburn LLP One Liberty Place - 46th Floor Philadelphia, PA 19103			ANYA, CHARLES E	
			ART UNIT	PAPER NUMBER
			2126	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,376

Applicant(s)

CIAPALA ET AL.

Examiner

Charles E Anya

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) 13-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-26 are pending in this application.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 12 and 23-26 Group I, drawn to a method of tracing a computer task by invoking a procedure from a first device to a second device and satisfying the tracing request at the second device, classified in class 719, subclass 330.
 - II. Claims 13 – 22 Group II, drawn to a method for developing software wherein an operator and a programmer communicate specification of one or more events that may occur during the operation of the software and subsequently running the software, classified in class 717, subclass 101.
3. Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. Group I is drawn to a method of tracing a computer task by invoking a procedure from a first device to a second device and satisfying the tracing request at the second device. Meanwhile Group II is drawn to a method for developing software wherein an operator and a programmer communicate specification of one or more events that may occur during the operation of the software and subsequently running the software. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions Group I

and Group II has separate utility such as the search for Group I invention is not required for Group II invention and vice versa. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I are not required for Group II and vice versa, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Peter Ullman on Oct. 14, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1 – 12 and 23-26.

7. Affirmation of this election must be made by applicant in replying to this Office action and applicant is required to cancel the non-elected claims. Claims 13 – 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

Art Unit: 2126

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-7,9 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. 6,760,903 B1 to Morshed et al.

11. As to claim 1, Morshed teaches a method for tracing a computing task in a distributed computing environment (figure 29 Col. 32 Ln. 50 – 67, Col. 33 Ln. 1 – 19), comprising: at a first device, issuing a first call to invoke a first procedure to be executed at a second device that is different from said first device (“...remote procedure call...” Col. 34 Ln. 64 – 67, Col. 35 Ln. 1 – 8), said first call including tracing information instructing said second device to provide event information regarding the execution of said first procedure at the second device (“...out of band data...” Col. 35 Ln. 18 – 31); at

Art Unit: 2126

said second device, receiving the first call and invoking the first procedure in response to said first call (figure 32 Col. 39 Ln. 1 – 15) and at said second device, providing event information in accordance with said tracing information (Col. 35 Ln. 27 – 31).

12. As to claim 2, Morshed teaches the method of claim 1, wherein said tracing information specifies a limitation on the content of the event information, and wherein said act of providing event information comprises providing a limited amount of event information in accordance with the specified limitation (“...out of band data...” Col. 35 Ln. 18 – 31).

13. As to claim 3, Morshed teaches the method of claim 1, wherein said event information includes property information descriptive of the event, and wherein said act of providing said event information includes providing said property information (Col. 35 Ln. 25 – 31, Col. 35 Ln. 42 – 62).

14. As to claim 4, Morshed teaches the method of claim 3, further comprising the act of deriving at least some of said property information from an environment present at said second device (Col. 35 Ln. 25 – 31, “...add data...” Col. 39 Ln. 16 – 31, Ln. 51 – 58, Col. 41 Ln. 28 – 31).

15. As to claim 5, Morshed teaches the method of claim 3, wherein said property information includes a plurality of attributes, wherein said tracing information specifies a

Art Unit: 2126

limitation as to a subset of said attributes, and wherein said act of providing event information includes providing attributed information limited in accordance with said subset (figure 39/40 Col. 47 Ln. 15 – 67).

16. As to claim 6, Morshed teaches the method of claim 1, wherein said first procedure produces a result, and wherein said method further comprises providing said result to said first device (Col. 39 Ln. 16 – 34):

17. As to claim 7, Morshed teaches the method of claim 1, wherein said first procedure issues a second call to invoke a second procedure at a third device different from said first device and said second device, and wherein said method further comprises including said tracing information, or information based on said tracing information, in said second call (Col. 37 Ln. 1 – 13, Col. 48 Ln. 44 – 60).

18. As to claim 9, Morshed teaches the method of claim 1, further comprising formatting said event information in accordance with a formatting convention (Col. 39 Ln. 16 – 31).

19. As to claim 23, Morshed teaches a system for supporting tracing in an application program which executes on a first computing device and which issues a call to a second computing device for at least some processing (figure 30 Col. 33 Ln. 20 – 55), the system comprising: a library residing on the first computing device comprising one or

Art Unit: 2126

more methods callable by the application program (“...several libraries...” Col. 34 Ln. 31 – 52), an event handler residing on the first computing device which receives events generated by calls to said methods, and which causes the generation of first tracing information in response to said events (“...COM DLL...” Col. 34 Ln. 53 – 63), and a trace service component which receives at least some of said tracing information and which generates a remote trace request for forwarding to the second computing device when said tracing information indicates that the application program has issued a call to the second computing device (Col. 36 Ln. 60 – 67, Col. 37 Ln. 1 – 4, Col. 39 Ln. 1 – 15).

20. As to claim 24, Morshed teaches the system of claim 23, wherein the call to the second computing device is represented in the form of a data structure to be transmitted to the second computing device over a communications medium (“...out of band data...” Col. 35 Ln. 18 – 31), and wherein said trace service component attaches the remote trace request to said data structure (Col. 39 Ln. 1 – 15, Col. 43 Ln. 51 - 67).

21. As to claims 25 and 26, see the rejection of claims 23 and 24.

22. Claims 8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 6,760,903 B1 to Morshed et al. in view of U.S. Pat. No. 6,446,137 B1 to Vasudevan et al.

23. As to claim 8, Morshed is silent with reference to the method of claim 1, wherein said second device is a member of a cluster of devices, and wherein said first call is issued to said cluster of devices and assigned to said second device, the identity of said second device being indeterminate at the time of said first call.

24. Vasudevan teaches the method of claim 1, wherein said second device is a member of a cluster of devices, and wherein said first call is issued to said cluster of devices and assigned to said second device, the identity of said second device being indeterminate at the time of said first call (Col. 5 Ln. 50 – 57, Col. 6 Ln. 9 – 38, Col. 12 Ln. 9 – 48).

25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morshed and Vasudevan because the system of Vasudevan would improve the system of Morshed by selecting appropriate server to service the event tracing request (fig 4a/b Col. 9 – 48).

26. As to claim 10, Morshed teaches a computer-readable medium having computer-executable instructions to perform acts comprising: determining that generation of event information is enabled /generating first event information indicative of a first event occurring during the operation of a program (Col. 34 64 – 67, Col. 35 Ln. 1 – 8, Ln. 18 – 31), and transmitting to said remote device information instructing said remote device to generate second event information indicative of a second event occurring during the operation of said procedure (Col. 35 Ln. 25 – 31).

Art Unit: 2126

Morshed is silent with reference to calling a procedure on a remote device whose location or identity is undetermined at the time of the call.

27. Vasudevan teaches calling a procedure on a remote device whose location or identity is undetermined at the time of the call (Col. 5 Ln. 50 – 57, Col. 6 Ln. 9 – 38, Col. 12 Ln. 9 – 48).

28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Morshed and Vasudevan because the system of Vasudevan would improve the system of Morshed by selecting appropriate server to service the event tracing request (fig 4a/b Col. 9 – 48).

29. As to claim 11, Morshed teaches the computer-readable medium of claim 10, wherein said generating act includes generating property information descriptive of said first event (Col. 34 Ln. 64 – 67, Col. 35 Ln. 1 – 8, Ln. 18 – 31).

30. As to claim 12, Morshed teaches the computer-readable medium of claim 11, wherein said property information comprises a plurality of elements (Col. 35 Ln. 49 – 62, figure 39/40 Col. 47 Ln. 15 – 67), wherein said transmitting act includes transmitting filtering information which limits the property information to be generated to a subset of said plurality of elements (Col. 35 Ln. 18 – 31).

Conclusion

Art Unit: 2126


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E Anya whose telephone number is (703) 305-3411. The examiner can normally be reached on M-F (8:30-6:00) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, An Meng-Ai can be reached on (703) 305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Charles E Anya
Examiner
Art Unit 2126

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